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Yasufumi Fukuma

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08/13/2004

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EXAMINER

DESIRE, GREGORY M

ART UNIT

PAPER NUMBER

2625

DATE MAILED: 08/13/2004

3

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/879,704

Applicant(s)

FUKUMA ET AL.

Examiner

Gregory M. Desire

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 12 and 27 is/are rejected.
- 7) ☐ Claim(s) 10 and 11 is/are objected to.
- 8) ☒ Claim(s) 13-26 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 22-26, drawn to eye test service, classified in class 382, subclass 117.
  - II. Claims 1-12 and 27, drawn to database, classified in class 382, subclass 305.
  - III. Claims 14-19 and 20-21, drawn to feature extraction, classified in class 382, subclass 190.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I, II and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the details of the broadest subcombination claim 1 of group II, for example, recites a statistical analyzing means which is not recited in the broadest combination claim 22 and the broadest subcombination claim 14 of group III, for example, recites a selecting analyzing means which is not recited in the broadest combination claim 22. The subcombinations have

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separate utility such as database system in-group II, a facial feature extraction in-group III, separate from the combination eye testing service in-group I.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II and III, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Robert J. Schneider on 7/1/04 a provisional election was made with traverse to prosecute the invention of group II, claims 1-13 and 21-27. Affirmation of this election must be made by applicant in replying to this Office action. Claims 14-26 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1- 6, 12 and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Gao et al (6,508,553).

Regarding claim 1, 2, 12 and 27 Gao discloses,

A web server for showing information on eyeglass frame (note col. 10 lines 20-30, lines cite using Internet to determine eyeglass frame parameters, wherein frame parameters show information on eyeglass frame).

A statistical analyzing means (which reads on processor 36) for dividing a personal facial picture into component to classify them into a type of every facial component (note col. 8 lines 17-25, examiner interprets processing step of calculating of facial parameters as dividing facial picture into component) and a statistically analyzing a relationship between the type of component and the selected eyeglass frame (note col. 8 lines 27-35, superimposing process show a relationship between facial component and eyeglass frame defined by a blending coefficient) in order to collect data for associating said personal facial type with said selected eyeglass frame on the basis

of the personal facial picture (note col. 9 lines 1-45 data collected from both facial feature and eyeglass frame is needed for the superimposing defined by blending coefficient) and the information on the eyeglass frame selected by the person transmitted to said web server using a web browser (note col. 10 lines 27-30 derived data transfer through modem via internet examiner interprets as such information transmitted to a web server, it is inherent that a web browser would be need for such transmission);

A memory means for associating and preserving information on said type of every facial component and said selected eyeglass frame (note col. 8 lines 17-25, database stores facial components and eyeglass frame).

Regarding claim 3 Gao discloses,

Wherein said statistical analyzing means divides automatically the personal facial picture into the component to classify them into a type of every facial component (note col. 8 lines 17-25, computer automatically calculates facial parameters), and analyzes statistically a relationship between the type of every facial component with said select eyeglass frame (col. 8 lines 27-29, superimposing analyzes relationship between facial features and an eyeglass frame).

Regarding claim 4 Gao discloses,

Further comprising a display means (note fig. 1 block 26 touch screen which reads on display means) for displaying the relationship between every type of every facial component and said selected eyeglass frame by a statistical method (note col. 6

line 66 - col. 7 line 3 and 18-20, composite image is printed must be displayed for printing).

Regarding claim 5 Gao discloses,

Wherein said statistical analyzing means (processor) has an extracting mean for extraction said facial component from said facial picture (note col. 13 lines 15-25, examiner interpret face edge detection as processing method that extract facial edge of a face).

Regarding claim 6 Gao discloses,

Wherein said facial component is selected from facial contour, hair, facial color, eyes, eyebrow, nose, ears, mouth and jaw (note col. 14 line- col. 15 line 40, lines identify facial components consisting of facial contour, facial hair, facial color, eyes, eyebrow, nose, ears, mouth and jaws)

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gao et al in view of Saigo (6,142,628).

Regarding claim 7,

Gao transmits facial picture to the database. However, Gao is silent wherein at least age and gender are transmitted to the database. Saigo discloses an administration screen, which inputs customer information and stores it in a database (note Saigo col. 8 line 64- col. 9 line 15, customer information includes age and gender). Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to include age and gender details transmitted to the database in the system of Gao. An administrative screen would have been a highly desirable feature in eyewear selection due to its database function and Saigo recognized that administrative screen input custom information would be expected when the age and gender transmitted to database in the system of Saigo is included in the system of Gao.

Regarding claim 8 Gao and Saigo discloses,

Wherein racial information is transmitted together with said facial to be reflected to the database construction (note col. 8 line 64- col. 9 line 15, racial information examiner characterizes as customer information that may be input in an administrative screen).

Regarding claim 9 Gao and Saigo discloses,

Wherein said selected eyeglass frame is subdivided into any of the combination of the components such as shape, color, material, marker name and designer name to be associated with said type of facial component (note Saigo col. 9 lines 50-67 and fig.



1 block 2, lines and figure classifies frame type from shape, color, material and brand name).

***Allowable Subject Matter***

11. Claims 10-11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. The following is a statement of reasons for the indication of allowable subject matter:

Regarding claims 10 and 11,

Prior art fails to discuss the critical feature of preference degree as described in specification page 22 lines 22-page 24 line 9. This feature of determining customer's preference by the time between selections is not taught in the prior art field of eyeglass or personal goods to wear.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory M. Desire whose telephone number is (703) 308-9586. The examiner can normally be reached on M-F (8:30-6:00) Second Monday off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bhavesh Mehta can be reached on (703) 308-5246. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gregory M. Desire  
Examiner  
Art Unit 2625



G.D.  
July 13, 2004